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Patent Cooperation Treaty Legal Office

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12 MAR 1998

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In re Application of
TOKMULIN et al
Application No.: 08/860,763
PCT No.: PCT/RU95/00063
Int. Filing Date: 11 April 1995
Priority Date: 13 January 1995
Attorney Docket No.: P-9701 ISK
For: DEVICE FOR TREATING PLANAR
ELEMENTS WITH A PLASMA JET

DECISION ON PETITION

This is a decision on applicants' "PETITION THAT THE DECLARATION BE ACCEPTED UNDER 37 CFR Ch. 1, 1.47 ABSENT TWO INVENTORS' SIGNATURES" filed in the Patent and Trademark Office (PTO) on 14 October 1997.

BACKGROUND

On 11 April 1995, applicants filed international application No. PCT/RU95/00063 which claimed a priority date of 13 January 1995, and which designated the United States.

On 02 August 1996, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date, and as a result the deadline for submission

of a copy of the international application (unless previously communicated by the International Bureau or filed in the United States Receiving Office) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e. 13 July 1997.

On 11 July 1997, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the basic national fee, a translation of the international application, and an unexecuted declaration of the inventors.

On 12 August 1997, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 14 October 1997, applicants filed the present petition which requests that the application be accepted without the signatures of two of the joint inventors, Oleg Sinyagin and Aleksandr Antropov. The petition was accompanied by, inter alia: two declarations of the inventors executed by five of the seven joint inventors; supplemental pages to the declaration of the inventors executed by the assignee on behalf of the non-signing inventors; a declaration of facts by Adrienne Shirley in support of the petition; the requisite petition fee; and the surcharge for late filing of the declaration.

DISCUSSION

First, it should be noted that, since five of the joint inventors have executed the declaration, the present request is properly considered under 37 CFR 1.47(a) and not 37 CFR 1.47(b).

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Item (1) has been satisfied.

With regards to item (2) above, section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

...Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the

refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature....

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the application file, and specifically the declaration of Ms. Shirley reveals that the 37 CFR 1.47(a) applicants have not filed an affidavit or declaration by someone having firsthand knowledge of the facts to support a holding that Mr. Sinyagin and Mr. Antropov refuse to execute the application papers. Specifically, all of the contact with the non-signing inventor has been through one of the signing inventors, Mr. Tokmulin. Additionally, Ms. Shirley's statement fails to set forth any specifics with regards to the attempts to obtain Mr. Sinyagin's and Mr. Antropov's signatures. Ms. Shirley's statement also has not been accompanied by documentary evidence supporting the alleged contacting of Mr. Sinyagin and Mr. Antropov. Finally, the declaration of Ms. Shirley fails to establish that Mr. Sinyagin and Mr. Antropov have been presented with a complete copy of the application papers including specification, claims, drawings, and oath or declaration.

With regards to item (3) above, the last known addresses as set forth in the present papers cannot be accepted as the last known addresses of the missing inventors. Specifically, the declaration of Ms. Shirley sets forth that a more recent address is known to the 37 CFR 1.47(a) applicants in that Mr. Tokmulin knows a more recent address of the missing inventors.

With regards to item (4) above, the declaration of the inventors has been accompanied by supplemental pages executed by the assignee on behalf of the non-signing inventors, and therefore the declaration cannot be accepted as having been signed by the signing inventors on behalf of both themselves and the non-signing inventors. Additionally, it is noted that the spelling of the last name of the second named inventor, Mr. Bagriy does not correspond to the name as set forth in the published international application.

Therefore, in that items (2) - (4) have not been satisfied, the petition may not be properly granted at this time.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

A proper response must include an acceptable showing that the missing inventors refuse to execute the application papers, a statement of the last known address of the non-signing inventors, and an acceptable declaration of the inventors as discussed above, or in the alternative an oath or declaration in compliance with 37 CFR 1.497 executed by all of the inventors.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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